

REMARKS

Claims 1-15 are pending in this application. Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Murray et al., U.S. 3,660,131. Claim 6 is rejected under 35 U.S.C. § 102(b) as anticipated by Reynolds et al., U.S. 3,494,731. Claims 1, 5, 9, 12, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Stiles et al., U.S. 3,563,700. Claim 10 stands rejected under 35 U.S.C. § 103(a) as obvious over Stiles et al. Claims 5 and 11-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray et al. in view of Reynolds.

Applicants thank the Examiner for indicating that claims 2-4, 7 and 8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicants have amended claims 1-3 and 8 in this fashion, and as such they are believed to be allowable. Claim 7, which depends from amended claim 1, is believed to be allowable as well. Claims 4 and 6 have been cancelled. Applicants respectfully submit that the amendments and new claim presented herein add no new matter.

Applicants respectfully request entry and consideration of the foregoing amendments, which are intended to place this case in condition for allowance.

The present amendments were not submitted at an earlier date as the Examiner's rejections were believed to have been fully met by the amendments and remarks made in the response to the previous Office Action. Thus, this response represents the Applicants' opportunity to make the present amendments and remarks a part of the record in this application. Entry is believed proper at this time because the amendments (1) do not raise any new issues that would require further consideration and/or search, since they are the same in scope and content to the claims already considered by the Examiner; (2) they do not introduce any new matter; and (3) they do not present additional claims.

I. The Claims Are Novel Over Murray et al.

Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Murray et al., U.S. 3,660,131. Applicants respectfully traverse this rejection.

Murray et al. fail to disclose each and every element of claim 1 as amended. Murray et al. fail to disclose the reaction of an aqueous solution of aluminum sulfate and a slurry of calcium hydroxide to form satin white, wherein the solids content during the reaction is at least 35% by weight, based on the weight of the reaction mixture, as required by claim 1.

As Murray et al. fail to disclose each and every element of claim 1, Applicants submit that claim 1 is novel over Murray et al. and that claim 14, which depends from claim 1, is likewise novel over Murray et al. Reconsideration and allowance of the claims over Murray et al. is therefore respectfully requested.

II. The Pending Claims Are Novel Over Reynolds

Claim 6 is rejected under 35 U.S.C. § 102(b) as anticipated by Reynolds et al., U.S. 3,494,731. Claim 6 has been cancelled, rendering this rejection moot.

III. The Pending Claims Are Novel Over Stiles et al.

Claims 1, 5, 9, 12, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Stiles et al., U.S. 3,563,700. Applicants respectfully traverse this rejection based on the claims as amended.

Stiles et al. fail to disclose each and every element of claim 1 as currently presented. Stiles et al. fail to disclose the reaction of aluminum sulfate and calcium hydroxide to form satin

white, wherein the solids content during the reaction is at least 35% by weight, based on the weight of the reaction mixture, as required by claim 1. Stiles et al. disclose a reaction mixture having only between 5 and 12 % solids, based on the weight of the reaction mixture. Col. 3, lines 57-59.

As Stiles et al. fail to disclose each and every element of claim 1, Applicants submit that claim 1 is novel over Stiles et al. and that claims 5, 9, 12, 14 and 15, which depend from claim 1, are likewise novel over Stiles et al. Reconsideration and allowance of the claims over Stiles et al. is therefore respectfully requested.

IV. The Pending Claims Are Non-Obvious Over Stiles et al.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as obvious over Stiles et al. Applicants respectfully traverse this rejection based on the claims as amended.

To serve as the basis for a *prima facie* case of obviousness, the combined references must teach or suggest all of the claim limitation. MPEP 2142-2143. As noted above, Stiles et al. fails to disclose each and every element of claim 1 as currently presented, from which claim 10 depends. As such, a *prima facie* case of obviousness cannot be established on the basis of Stiles et al. standing alone. Reconsideration and allowance of claim 10 over Stiles et al. is therefore respectfully requested.

V. The Pending Claims Are Non-Obvious Over Murray et al In View Of Reynolds.

Claims 5 and 11-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Murray et al. in view of Reynolds. Applicants respectfully traverse this rejection based on the claims as amended.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate some motivation to combine the references and must establish a reasonable expectation of success. Finally, the combined references must teach or suggest all of the claim limitation. MPEP 2142-2143. The Examiner has not provided any motivation to modify the teachings of Murray et al. with those of Reynolds, and in fact the two teach away from each other. The reaction of Murray et al. utilizes aqueous solutions of slaked lime or calcium hydroxide, sodium hydroxide and alum or aluminum sulfate. See col. 1, lines 46 to col. 2, line 16. Reynolds, on the other hand, requires the reaction be carried out in the solid or semi-solid state to ensure saturation of both reactants. Col. 4, lines 6-10. Additionally, there would be no expectation of success in taking an ingredient of Reynolds and adding it to the very different process of Murray et al. Further, as noted above, Murray et al. fail to teach each and every element of claim 1, from which claims 5 and 11-13 depend, and Reynolds does not cure the deficiencies of Murray et al. As such, a *prima facie* case of obviousness cannot be established.

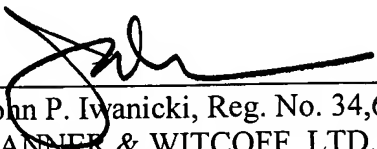
VI. Conclusion

Applicants submit that all of the claims are now in condition for allowance, which action is requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-referenced application, the Examiner is urged to call the undersigned at the number below.

The Commissioner is hereby authorized to apply any required charges or credits to our
Deposit Account No. 19-0733.

Respectfully submitted,

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